

REMARKS/ARGUMENTS

In the specification, the abstract has been amended so that the length does not exceed the 150 word maximum. The amended abstract now consists of 148 words and thereby falls within the proper format range. In the claims, claims 23, 27 – 29, and 32 – 34 have been canceled, without prejudice. Moreover, claims 1, 6, 14, and 19 (as well as claims 2 – 5, 7 – 13, 15 – 18, 20 – 22 and 24 – 26, dependent thereon, respectively) have been amended, for the sake of clarity, to remove the phrase “*the like*”, and replace that phrase with the phrase “investment issues”. Each of these amendments is clearly supported by the original specification, particularly at: page 3, lines 13 – 20; page 4, lines 7 – 11; and page 5, lines 22 – 23.

In addition, in order to expedite prosecution of this application, enclosed herewith is a Terminal Disclaimer in the form required by 37 CFR §1.321(c) and in compliance with 37 CFR §3.73(b). In view of the same, and for the reasons set forth hereinafter, it is respectfully submitted that the rejection of claims 1 – 22, 24 – 26, and 30 – 31 based on double patenting has been obviated.

Applicants wish to express their appreciation to the Examiner for withdrawing the former restriction between Groups I and II and for subsequently allowing Groups I and II to be combined for examination in the subject application. Pursuant to the October 19, 2004 Office Action, the Examiner had required restriction under 35 USC § 121 between the following inventions: Group I. Claims 1-18, 21, 22, 24 – 26 and 30 – 31; Group II. Claims 19 – 20; Group III. Claim 23; and Group IV. Claims 27 – 29 and 32 – 34. The Examiner has subsequently ruled that the arguments presented in applicant’s November 12, 2004 response, for combining Groups I and Group II claims for examination purposes were persuasive. Accordingly, the Examiner has withdrawn the restriction between Groups I and II. The Examiner further stated that applicant’s arguments for combining the other groups were not persuasive, and that those restrictions should be maintained. In response to the further restriction

requirement, Applicants hereby elect, with traverse, the invention of Groups I and II, i.e. claims 1 – 22, 24 – 26, and 30 – 31, for further prosecution on the merits. Non-elected claims 23, 27 – 29, and 32 – 34 have been canceled, without prejudice.

The Examiner has objected to applicant's abstract due to the length, which exceeded 150 words. The Examiner has stated that the abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within a range of 50 to 150 words. The Examiner explained that it is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. In compliance with the Examiner's request, the abstract has been amended. As amended, the abstract now contains 148 words. Applicants respectfully submit that the amended abstract is in proper form and abides by the word limitation.

Accordingly, reconsideration of the objections to the abstract as being unduly long is respectfully requested.

Claims 1, 6, 14, and 19 were rejected under the second paragraph of 35 USC §112 for failing to particularly point out and distinctly claim the subject matter that the applicants regard as their invention. Specifically, the Examiner has indicated that the phrase "*and the like*" utilized in claims 1, 6, 14, and 19 renders the claims indefinite because the claims include elements not actually disclosed. Claims 2 – 5, 7 – 13, 15 – 18, 20 – 22 and 24 – 26 were rejected because they depend on rejected independent claims 1, 6, 14, and 19. Claims 1, 6, 14, and 19 (as well as claims 2 – 5, 7 – 13, 15 – 18, 20 – 22 and 24 – 26, dependent thereon) have been amended to remove the phrase "*the like*", replacing the phrase with the phrase "investment issues", which element is particularly pointed out and distinctly described out throughout the specification. Applicants respectfully submit that as amended, claims 1, 6, 14, and 19 (as well as claims 2 – 5, 7 – 13, 15 – 18, 20 – 22 and 24 – 26, dependent thereon) are no

longer indefinite, and that all elements thereof are disclosed by the specification in compliance with the second paragraph of 35 USC §112.

Accordingly, reconsideration of the rejection of claims 1, 6, 14, and 19 (as well as claims Claims 2 – 5, 7 – 13, 15 – 18, 20 – 22 and 24 – 26 dependent thereon) under the second paragraph of 35 USC §112 for failing to particularly point out and distinctly claim the subject matter that the applicants regard as their invention is respectfully requested.

As amended, claim 1 (and claims 2 – 5, 21 – 22, 24 – 26, and 31, dependent thereon) provide a method of presenting to a user a plurality of answer-options to an issue-question relating to personal finance and investment, in a computer having a processor, an input device, a memory storage device and an output device. The method comprises the steps of: (a) identifying and storing in the memory storage device a plurality of topics relating to personal investment and finance; (b) developing and storing in the memory storage device a plurality of issue-questions directed to each of the stored topics; (c) developing and storing in the memory storage device an expert opinion for each issue-question; (d) developing and storing in the memory storage device a prudent-investor opinion, said opinion being from persons having actual, hands-on, practical experience with specific financial issues, situations and investment issues, regardless of whether that person is actively and regularly engaged in investment matters, or maintains an active portfolio of investment properties, for each issue-question; (e) selecting, by the user via the input device, a topic; (f) selecting, by the user via the input device, an issue-question directed to the selected topic; and (g) providing to the computer output device a plurality of answer-options to the selected issue-question, the plurality of answer-options comprising at least one expert opinion and one prudent-investor opinion and forming a response that is polycentric and tailored to said issue-question.

In addition, amended claim 6 (as well as claims 7 – 13, dependent thereon), amended claim 14 (as well as claims 15 – 18, dependent thereon), amended claim 19 (as well as claim 20, dependent thereon), and claim 30, similar to claim 1, provide methods that yield a plurality of answer-options to an issue-question relating to personal finance and investment, providing a polycentric information product concerning personal investment and finance.

The Examiner rejected claims 1 – 22, 24 – 26, and 30 – 31 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 – 20 of U.S. Patent No. 6,193,518 to Nocera (hereinafter, the “‘518 patent”). The Examiner has indicated that although the conflicting claims are not identical, they are not patentably distinct from each other because they recite the means or steps that are substantially the same and would have been obvious to one of ordinary skill in the art. In addition, the Examiner has indicated that even though the ‘518 patent and the subject application are not in the same field of endeavor (“*child development*” versus “*personal finance and investment*”, respectively), the method of the ‘518 patent is reasonably pertinent to the problem with which the applicant is concerned, namely “*providing to a user a plurality of answer-options to an issue-question.*”

Applicants respectfully submit that the scope and content of the ‘518 patent does not support an obviousness rejection. Specifically, applicants submit that the ‘518 patent cannot be relied upon as a basis for rejection of applicant’s subject application because the ‘518 patent is not in the field of applicant’s endeavor, nor is it reasonably pertinent to the particular problem with which the subject application is concerned. MPEP §2141.01(a). Particular problems with which the subject application is concerned include: (i) the need for people of all socio-economic classes to have access to a one-stop forum of information, which assists them to successfully manage their personal finances; (ii) the need for financial information and advice on a broad spectrum of topics distributed in many different

mediums, as opposed to specific issue-questions; (iii) the need for the average investor have available means to research data and financial information over the Internet without being subjected to financial information overload; and (iv) the need for the average investor to have access to a plurality of points of view instead of singular points of view. Advantageously, applicant's present claims 1 – 22, 24 – 26, and 30 – 31 provide a method whereby (i) financial information is presented as a broad spectrum of views; (ii) rationales for the views are set forth; (iii) the rationales are applied to specific fact patterns having particular relevance to salient factors affecting a particular investment decision. The '518 patent is not reasonably pertinent to the particular problems with which the applicant's subject invention is concerned, but instead deals with child development issues. However, in order to expedite prosecution of this application, enclosed herewith is a Terminal Disclaimer in the form required by 37 C.F.R. §1.321(c) and in compliance with 37 C.F.R. §3.73(b). In view of the same, it is respectfully submitted that the rejection of claims 1 – 22, 24 – 26, and 30 – 31 on the basis of non-statutory double patenting has been obviated.

Accordingly, reconsideration of the rejection of claims 1 – 22, 24 – 26, and 30 – 31 based on the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 – 20 of U.S. Patent No. 6,193,518 to Nocera is respectfully requested.

Claims 1 – 22, 24 – 26, and 30 – 31 were rejected under 35 USC 103 as being unpatentable over U.S. Patent No. 5,842,221 to Schmonsees in view of U.S. Patent No. 6,154,732 to Tarbox. The Examiner has indicated that Schmonsees discloses methods of providing a user with answer-options to an issue-question, in a computer having a processor, an input device, a memory storage device and an output device. The Examiner has further indicated that the method disclosed by Schmonsees comprises the steps of: identifying and storing in the memory storage device a plurality of topics relating to a field of endeavor; developing an storing in the memory storage device a plurality of issue-

questions directed to each of the stored topics; developing and storing in the memory storage device an answer for each issue-question; selecting, by the user via the input device, a topic, and an issue-question directed to the selected topic; and providing to the computer output device answer-options to the selected issue-question, that is polycentric and tailored to the issue-question. To support this position, the Examiner has pointed to Schmonsees' abstract, column 2 lines 8 – 20, and claim 7.

The Examiner has postulated that (i) the answer and links corresponding to the selected question in Schmonsees are interpreted to include a response that is polycentric and tailored to the specific issue-question; (ii) although Schmonsees does not explicitly disclose the steps wherein the field of endeavor is personal investment, such field of endeavor is obvious in view of Tarbox; (iii) although Schmonsees does not explicitly disclose the steps wherein the answers include an expert opinion and a prudent-investor opinion for each issue-question, such would be obvious in view of Tarbox; (iv) Tarbox discloses the steps wherein the field of endeavor is personal investment and finance (Tarbox Abstract and Column 1 lines 5 – 16); (v) Tarbox discloses that the answers include an expert opinion (Tarbox column 2 lines 27 – 30) and a prudent-investor opinion (Tarbox column 4 lines 13 – 17) for each issue-question; and (vi) it would have been obvious to one with ordinary skill in the art at the time of invention to include steps taught by Tarbox to the invention of Schmonsees. In addition, the Examiner has indicated that the combination of the disclosures taken as a whole suggests that it would have helped a user get answers from experts to his / her questions in the field of personal finance and investments in a dynamic fashion. Applicants respectfully disagree with the Examiner's obviousness rejection.

It is respectfully submitted that Schmonsees does not disclose answers and links corresponding to selected questions to produce a response that is polycentric and tailored to a specific issue-question. Moreover, Schmonsees cannot properly be interpreted, either alone or in combination with Tarbox, as

including this novel feature. Rather, Schmonsees discloses a system for creating and managing a data base of Frequently Asked Questions (FAQ) and a user navigation system that allows users to interact with the system. The FAQs provide the user with a list of commonly recurring questions, together with some means for identifying answers to the questions. (Schmonsees column 1 lines 17 – 19). Schmonsees provides that each question may be grouped in many-to-one relationships with various topics, linked in a one-to-one relationship with an answer, and where each question may also be linked in a one-to-many relationship with other questions, answers, and other information so that when a user selects a topic and a question, the user receives the answer to the question and links to related information. (Schmonsees column 2 lines 8 – 15).

A link is defined by Schmonsees as “an electronic connection either directly or indirectly to: (a) other knowledge objects (a topic, a question, or an answer that also contains at least one link); (b) digital information; and / or (c) hyper text.” (Schmonsees column 2 lines 16 – 28). Schmonsees does not disclose a plurality of answers for each issue-question, but rather discloses a single answer in response to a frequently asked question and further provides at least one link to other topics, questions, answers, and to information stored outside the data base. (Schmonsees column 4 lines 8 – 14).

The Examiner has stated that the answers and links corresponding to the selected question in Schmonsees are interpreted to include a response that is polycentric and tailored to the issue-question. This statement of the Examiner is, respectfully, traversed. The system in Schmonsees does not disclose nor suggest that a question has a plurality of answers, much less that the answers comprise at least one expert opinion and one non-expert opinion (herein known as the prudent-investor). At most, Schmonsees provides links related to the specific question, wherein the link *may* contain a *similar* topic, question, answer, or external data. This feature goes against the very grain of the invention defined by applicants’ claims 1 – 22, 24 – 26, and 30 – 31 in that the Schmonsees user must continue

to navigate throughout the system in order to find the answer they are seeking. At no time (including the time required for continued navigation) is the Schmonsees user provided with a plurality of answers from different points of view. Instead, the Schmonsees user is merely provided with a single answer and at least one link. Consequently, the Schmonsees user must click on the link and enter a separate page to view the related content. Furthermore, there is no indication that the link provides another tailored answer to the issue question. Rather, the Schmonsees teaching merely indicates that the user is directed to related information.

The Examiner has stated that Tarbox discloses answers that include an expert opinion and a prudent-investor opinion, citing Tarbox column 2 lines 27 – 30 and column 4 lines 13 – 17. Applicants agree with the Examiner that an expert opinion is rendered. However, applicants respectfully disagree that Tarbox discloses answers that include both an expert and a prudent-investor opinion. Tarbox discloses an investment program which provides a system and a method for collecting, monitoring and directing data from Benefit Plan participants and beneficiaries, sponsors and fund managers, to provide professional investment advice to Benefit Plan participants. (Tarbox column 1 lines 6 – 14). Column 2 lines 27 – 30 in Tarbox specifically teach that the processing system provides expert independent investment advice to Benefit Plan participants.

The investment program disclosed by Tarbox provides professional asset allocation advice services, via investment advisors, to individual participants, specifically tailored to their individual risk tolerances and retirement funding needs. (Tarbox column 3 lines 21 – 28). Column 4 lines 6 – 14 in Tarbox discloses appropriate asset allocation proportionate to the age of the participants and each participant's funding needs, thereby varying the weightings of each Trusts' holdings so that each Trust is tailored to meet different retirement investment needs. Tarbox does not disclose a prudent-investor answer, as required by applicants' claims 1 – 22, 24 – 26, and 30 – 31. In fact the teaching at column 4,

lines 12-17 of Tarbox -- that professional asset allocation advice services are rendered in order to provide each participant with advice via prudent practices and procedures of retirement funding -- points away from such an investor. Tarbox Participants fill out a worksheet to provide answers to questions, such as age, annually salary, etc., which are utilized to determine the risk tolerance of the participant and the recommended Trust. (Tarbox column 6 lines 47 – 61 and column 7 lines 1 – 6).

Neither Schmonsees nor Tarbox, taken alone or in combination, provide a plurality of answer-options to the selected issue-question, wherein each of the answer-options comprises at least one expert opinion and at least one prudent-investor opinion to produce a polycentric information product. Schmonsees provides a question and answer platform wherein a single answer is provided along with at least one link. Tarbox provides an investment program wherein an investor's risk level is determined by answering specific questions, and wherein an expert financial advisor determines the proper allocation of the investor's assets in various Trust accounts.

For quite some time the art has struggled to devise a method of providing financial information presented as a broad spectrum of views that applies to specific fact patterns having particular relevance to salient factors affecting investment decisions. Yet, up until the time of this invention no device capable of providing a broad spectrum of views presented in a polycentric fashion tailored to the specific question presented has been proposed by any prior art worker, including Schmonsees and Tarbox. The prior art inventions and their attendant disadvantages are discussed at pages 1 – 3 of the specification. It is submitted that any combination of Schmonsees in view of Tarbox would require substantial reconstruction and redesign of the method and function of the Schmonsees system, which is not disclosed by the secondary reference. Accordingly, it is submitted that the proposed combination of Schmonsees and Tarbox cannot properly be made in the absence of applicant's own disclosure.

Assuming, arguendo, that the Schmonsees and Tarbox references can be combined in the manner proposed by the Examiner, the resultant structure would still not possess an answer to a specific issue-question that contains both an expert opinion and a prudent-investor opinion, and which is polycentric and tailored to the specific question presented. Rather, any method practiced in light of the Schmonsees and Tarbox teachings would yield an expert opinion solely. Neither reference teaches providing an answer containing plural components, one of which consists of a non-expert or prudent-investor opinion. As such, any method provided from the combined teachings of the cited references would produce an answer that presents a single point of view, namely, that of the author-expert; and would not provide the user with a one-stop information forum. At best, any method practiced in light of the Schmonsees and Tarbox teachings would produce an answer together with at least one link that is related, but is not specific to, the user's issue-question. The continued navigation required of a user practicing the Schmonsees / Tarbox method would have to open a separate page, and further continue the searching process without any definitive prospect that the additional related information would be sufficiently tailored to provide an appropriate expert or prudent investor answer. In contrast to the teachings of the cited references, applicant has surprisingly discovered that combining together both expert and non-expert or prudent-investor opinions, as required by applicant's claims 1 – 22, 24 – 26, and 30 – 31, provides a single forum presenting answers that are focused on the issue-questions presented in a polycentric, tailored manner.

Accordingly, reconsideration of the rejection of claims 1 – 22, 24 – 26, and 30 – 31 under 35 USC 103, as being obvious over the combination of Schmonsees and Tarbox is respectfully requested.

In view of the election of present claims 1 – 22, 24 – 26, and 30 – 31, the cancellation of claims 23, 27 – 29, and 32 – 34, the amendment to claims 1, 6, 14, and 19, the Terminal Disclaimer submitted herewith, and the remarks set forth above, it is submitted that the present application is in allowable

condition. Reconsideration of the rejection of claims 1 – 22, 24 – 26, and 30 - 31, as amended, and their allowance are earnestly solicited.

Respectfully submitted,
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